REMARKS

By this Amendment, Applicants amend claims 7, 17, 20, 21, 22, and 23 for clarity and to more appropriately define the present invention. No new matter is introduced. Claims 7, 9, and 17-23 are currently pending in this application.

In the Office Action mailed December 23, 2003, the Examiner rejected claim 9 under 35 U.S.C. § 102(b) as anticipated by Backman et al. (U.S. Patent No. 5,902,347); rejected claim 7 under 35 U.S.C. § 103(a) as unpatentable over Backman in view of Saylor et al. (U.S. Patent No. 5,487,139); rejected claims 17, 18, and 23 under 35 U.S.C. § 103(a) as unpatentable over Saylor in view of DeLorme et al. (U.S. Patent No. 5,848,373); rejected claims 19-21 under 35 U.S.C. § 103(a) as unpatentable over Saylor in view of DeLorme and in further view of "Accuracy of Mapping Products," and rejected claim 22 under 35 U.S.C. § 103(a) as unpatentable over Saylor in view of DeLorme and in further view of Kuo (U.S. Patent No. 5,596,494). Applicants respectfully traverse these rejections for the following reasons.

The Examiner rejected claim 9 under 35 U.S.C. § 102(b) as anticipated by Backman. To properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Applicants' claim 9 recites a combination including, among other things, "a processing platform for executing code capable of georeferencing a digital raster map by associating points on the digital raster map with known reference points in the digital raster map." By contrast, Backman discloses retrieving georeferenced map data from a storage system and using position information received from a GPS receiver to create an image showing a user's position on a color display. See col. 2, lines 10-12. Backman also discloses editing raster-format digitized maps using software. See col. 2, lines 21-23. Backman, however, does not disclose at least "a processing platform for executing code capable of georeferencing a digital raster map by associating points on the digital raster map with known reference points in the digital raster map," as recited in claim 9. Instead, Backman merely discloses showing a user's location on a map that has already been georeferenced by receiving GPS data. Because Backman does not disclose all of the elements of claim 9, it cannot anticipate the claim. Accordingly, the Examiner should withdraw the rejection and allow claim 9.

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as unpatentable over Backman in view of Saylor. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See

-8-

M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Applicants' claim 7 recites a combination including, among other things, "a processing platform for executing code capable of georeferencing a digital raster map by associating points on the digital raster map with corresponding points on a previously georeferenced vector map, wherein the digital raster map and the previously georeferenced vector map are displayed in separate areas of a display and share at least a portion of a geographic area in common." Backman and Saylor, taken alone or in combination, do not disclose or suggest at least these features.

As discussed above, Backman discloses showing a user's location on a map that has already been georeferenced by receiving GPS data. In fact, the Examiner admits Backman does not disclose associating points on the digital raster map with corresponding points on a previously georeferenced vector map (Office Action, p. 3). Saylor, however, does not make up for the deficiencies of Backman. Instead, Saylor discloses using a vector database to create a vector map that is aligned with a raster map produced from an existing hand-drawn map. An existing cartographic drawing is scanned to create the raster map. See col. 4, lines 51-53. Vector information corresponding to the raster map is received from a vector background database to generate the vector map. See col. 5, lines 15-20. The raster map and the vector map are aligned. See col. 5, lines 29-31. The system retrieves X, Y coordinate information for a power service interruption location, and displays that location so as to appear overlapped on the raster map. See col. 7, lines 40-52.

For example, in the portion of Saylor cited by the Examiner, Saylor discloses that corresponding areas of the vector map and the raster map are substantially aligned. See col. 2, lines 37-40. Saylor thus discloses aligning two maps over each other and then displaying a location. However, Saylor does not disclose or suggest at least "a processing platform for executing code capable of georeferencing a digital raster map by associating points on the digital raster map with corresponding points on a previously georeferenced vector map, wherein the digital raster map and the previously georeferenced vector map are displayed in separate areas of a display and share at least a portion of a geographic area in common," as recited in claim 7. Accordingly, the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

The Examiner rejected claims 17, 18, and 23 under 35 U.S.C. § 103(a) as unpatentable over Saylor in view of DeLorme. Applicants' claim 17 recites a combination including, among other things, "means for assigning to the points on the first map a longitude coordinate and a latitude coordinate which are identical to the longitude coordinate and latitude coordinate of their corresponding points on the second map; and means for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair." Saylor and DeLorme, whether taken alone or in combination, do not disclose or suggest at least these features.

As discussed above, Saylor discloses aligning two maps over each other and then displaying a location. In particular, Saylor merely discloses that corresponding areas of the vector map and the raster map are substantially aligned. See col. 2, lines 37-40. Once the maps are aligned, Saylor discloses that information from a utility

-10-

company's existing customer database can be defined on the map. See col. 5, lines 54-66. However, Saylor does not disclose or suggest at least "means for assigning to the points on the first map a longitude coordinate and a latitude coordinate which are identical to the longitude coordinate and latitude coordinate of their corresponding points on the second map; and means for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair," as recited in claim 17.

Additionally, DeLorme does not make up for the deficiencies of Saylor. DeLorme disclose a computer aided map location system (CAMLS) that provides correlation and coordination of spatially related data between a computer and a set of printed maps typically printed on paper that depict surface features at desired levels of detail. Accordingly, because Saylor and DeLorme, whether taken alone or in combination, fail to disclose or suggest all of the elements of claim 17, the Examiner should allow the claim.

In addition, there is no motivation or suggestion to combine Saylor and DeLorme in the manner the Examiner suggests. The Examiner has applied DeLorme for the proposition that its Fig. 6 discloses displaying maps side by side. However, as discussed above, Saylor teaches that corresponding areas of the vector map and the raster map are aligned. Accordingly, one of skill in the art would not be motivated to combine Saylor's teachings that require overlapping the maps with the maps displayed on a monitor as shown in Fig. 6 of DeLorme. In fact, Saylor teaches away from such a combination. Nor has the Examiner shown any reasonable expectation of success in making the proposed combination. To the contrary, such teaching away of Saylor

demonstrates that there would be no reasonable probability of success. For at least these additional reasons, the Examiner should withdraw the rejection and allow claim 17.

Claim 18 depends from allowable claim 17 and is allowable at least due to its dependency. Claim 23, while of a different scope, includes recitations similar to those of claim 17. For example, claim 23 recites a combination including, among other things, "facilities for assigning to the points on the first map a longitude coordinate and a latitude coordinate which is identical to the longitude coordinate and latitude coordinate of their corresponding points on the second map; and facilities for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair." Accordingly, the Examiner should allow claims 17 and 23.

The Examiner rejected claims 19-21 under 35 U.S.C. § 103(a) as unpatentable over Saylor in view of DeLorme and in further view of "Accuracy of Mapping Products." Claims 19-21 depend from claim 17. As discussed above, Saylor and DeLorme, whether taken alone or combination, do not disclose or suggest all of the features of claim 17. Moreover, "Accuracy of Mapping Products" does not cure the defects of Saylor and DeLorme. Instead, "Accuracy" merely teaches a standard deviation technique. Because the references do not disclose or suggest every element of claims 19-21, the Examiner should allow claims 19-21.

The Examiner rejected claim 22 under 35 U.S.C. § 103(a) as unpatentable over Saylor in view of DeLorme and in further view of Kuo (U.S. Patent No. 5,596,494). Claim 22 depends from allowable claim 17. As discussed above, Saylor and DeLorme,

taken alone or in combination, do not disclose or suggest the features of claim 17.

Furthermore, <u>Kuo</u> does not cure the defects of <u>Saylor</u> and <u>DeLorme</u>. <u>Kuo</u> merely

teaches general rotational linear transformation. Because the cited references do not

disclose or suggest every element of claim 22, the Examiner should also allow claim 22.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration

and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 23, 2004   By:_____ Reg. No.53,232
                                   Richard V. Burgujian
                               for Reg. No. 31,744

-13-